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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/456,793	12/08/1999	Christopher L. Knauft	MEDIDNA.049A	6923

30948 7590 03/08/2006

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EXAMINER	
NGUYEN, MAIKHANH	

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/456,793	KNAUFT ET AL.	
	Examiner	Art Unit	
	Maikhanh Nguyen	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 12/14/2005 to the original application filed 12/08/1999.

2. Claims 1-27 are currently pending in this application. Claims 1, 12, and 25 have been amended. Claims 1, 12, 19, and 25 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> *(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*
>
> *(b) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).*

4. Claims 1-27 remain rejected under 35 U.S.C. 103(a) as being unpatentable over **Judd et al.** (U.S. 6,360,215 – filed 11/1998) in view of **Kirsch et al.** (U.S. 5,920,854 – issued 07/1999).

As to claim 12:

a. Judd teaches a method of providing index information for secure graphical or audio objects *(see the Abstract)*, the method comprising:

(i) reading index information *(col.3, lines 7-8)* that is associated with a secure graphical or audio object *(col.3, lines 33-45)*, wherein the index information is structured for use in an index database of a search engine system *(e.g., structures and files for index 16 may be provided ... index may include a word list "lexdata" file that contains a list of all words in the database ... It may be used by the search engine 14; col.15, lines 3-16)*, and wherein the search engine systems do not have full access to the secure graphical or audio object *(col.3, lines 21-32),* and wherein search engine do not have access to the index information associated with the secure graphical or audio object (e.g., *storing a tag word in an index in association with information identifying the electronic document, in which the tag word indicates that access to the electronic document is restricted; col.3, line 2-col.3, line 3 & lines 24-27*); and

(ii) transmitting the index information to the search engine system *(e.g., a search system for the World Wide Web, including a Web crawler or 'spider' system, an index of Web document, and a search engine that can receive a search query and find matching information in the index; col.5, lines 53-56 & also see fig.1 and the associated text)*, wherein the index information is for use in the index database of the search engine system *(e.g., a search query...an index of a search engine...a hypertext of*

database; col. 5, lines 55-65. See also, the SEARCHING THE INDEX discussion, beginning at col.8, line 21).

b. Judd, however, does not specifically teach "*obfuscating at least a portion of the index information so that the intelligibility of the index information is reduced.*"

c. Kirsch teaches obfuscating at least a portion of the index information so that the intelligibility of the index information is reduced *(e.g., col.9, lines 40-46; col.10, lines 8-65 & also see fig.3).*

d. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature from Kirsch in the system of Judd because it would have provided the capability for effectively filtering performance of the term filter may be dynamically improved to focus more on terms likely to carry contextual significant.

As to claim 13:

a. Judd does not specifically teach "*a portion of the index obfuscated information.*"

b. Refer to claim 12 above for rejection the use of obfuscation.

As to claim 14:

Judd teaches customizing, is based at least in part upon the contents of the index characteristics of one or more the search engine systems *(col.10, lines 19-44).*

As to claim 15:

Judd teaches a HyperText Markup Language file *(e.g., Hypertext Markup Language; col.7, lines 19-31).*

As to claim 16:

Judd teaches a bitmap image *(col.1, lines 55-57).*

As to claim 17:

Judd teaches the secure graphical object is a multimedia presentation *(col.7, lines 10-31 and col.17, lines 25-27).*

As to claim 18:

Judd teaches the graphical object is a stream media file *(col.6, lines 2-5).*

As to claim 1:

The rejection of claim 12 above is incorporated herein in full. Additionally, Judd teaches converting at least a portion of a secure audiovisual object into index information *(col.10, lines 19-36 and see fig. 2b).*

As to claims 2 and 3-5:

They incorporate the same limitations as in claims 13 and 20-22 above, and are rejected along the same rationale.

As to claim 6:

Judd teaches music *(col.1, lines 39-52).*

As to claim 7:

Judd teaches identifying one or more words in the lyrics of the music *(col.1, lines 39-52).*

As to claim 8:

It incorporates the same limitations as in claim 17 above, and is rejected along the same rationale.

As to claim 9:

Judd teaches reading close captioned information that is associated with the audiovisual object *(col.5, lines 19-41).*

As to claim 10:

Judd teaches a streaming media file *(col.6, lines 2-5).*

As to claim 11:

It incorporates the same limitations as in claim 9 above, and is rejected along the same rationale.

As to claim 25:

a. The rejection of claim 12 above is incorporated herein in full. Additionally, claim 25 recites "*dynamically generating an electronic document based at least in part upon the contents of the index information; and transmitting the electronic document to the search engine system.*"

b. Kirsch teaches dynamically generating an electronic document based at least in part upon the contents of the index information *(col.4, lines 17-27)*; and transmitting the electronic document to the search engine system *(col.7, lines 28-40 and col.9, lines 1-16).*

c. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature from Kirsch in the system of Judd because it would have provided the capability for establishing a collection search engine that is responsive to a user query against a collection of documents to provide a search report.

As to claim 26:

Judd teaches customizing the electronic document, wherein the customizing is based at least in part upon the contents of the index characteristics of one or more the search engine systems *(col.10, lines 19-44)*.

As to claim 27:

It incorporates the same limitations as in claim 15 above, and is rejected along the same rationale.

As to claim 19:

It is directed to a system for performing the method of claim 25 above, and is rejected along the same rationale. Additionally, Judd teaches a web server connected to a network *(see fig.1 and the accompanying text beginning at col.5, line 62)*, said web server operable to manage a content owner's secure graphical or audio objects including granting and denying access to secure content requesters, wherein search engine systems are denied access to said objects *(col.3, lines 21-45)*.

As to claims 20-21:

They incorporate the same limitations as in claims 26-27 above, and are rejected along the same rationale.

As to claims 22-24:

They incorporate the same limitations as in claims 5, 8 & 10 above, and are rejected along the same rationale.

Response to Arguments

5. Applicant's arguments filed 12/14/2005 have been fully considered but they are not persuasive.

a. Applicant argues that *there appears to be no suggestion or motivation to combine the cited prior art references* [Remarks, page 11, last paragraph].

Examiner notes that the test for the relevance of a cited combination of references is: "whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention," *In re Gorman*, 933 F.2d at 986, 18 USPQ2d at 1888. Subject matter is unpatentable under section 103 if it would have been obvious ... to a person having ordinary skill in the art. While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the combination: *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)." Such suggestion or motivation to combine prior art teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same [or] similar problem which it addresses. *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979). "In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to

have been obvious unless a suggestion to combine prior art teachings is found in a specific reference." *In re Oetiker*, 24 USPQ2d 1443 (CAFC 1992).

b. Applicant argues that *Judd teaches a search engine construct an index, but does not teach having index information for use in an index database of a search engine system* [Remarks, page 12].

In response, Judd teaches index information for use in an index database of a search engine system *(e.g., a search query...an index of a search engine...a hypertext of database; col. 5, lines 55-65. See also, the SEARCHING THE INDEX discussion, beginning at col.8, line 21).*

c. Applicant argues that *Judd does not teach a search engine is restricted* [Remarks, page 12].

In response, Judd teach a search engine is restricted *(e.g., storing a tag word in an index in association with information identifying the electronic document, in which the tag word indicates that access to the electronic document is restricted; col.3, line 2-col.3, line 27 and col.16, lines 47-52).*

d. Applicant argues that *Judd does not teach transmitting index information to a search engine* [Remarks, page 14].

In response, Judd's teachings *"a search system for the World Wide Web, including a Web crawler or 'spider' system, an index of Web document, and a search engine that can receive a search query and find matching information in the index"* (col.5, lines 53-56 & also see fig.1 and the associated text) meet *"transmitting index information to a search engine"* as claimed.

e. Applicant argues that *Kirsh does not mention "obfuscate"* [Remarks, page 13].

In response, Kirsch teaches the use of obfuscation *(e.g., col.9, lines 40-46; col.10, lines 8-65 & also see fig.3; generating document 66 by removing words from document 62 that occur frequently, resulting in content that is less intelligible).*

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-	Caid et al.	U.S. Patent No. 5,794,178	Issued: Aug. 11, 1998
-	Burrows	U.S. Patent No. 5,864,863	Issued: Jan. 26, 1999
-	Meyerzon et al.	U.S. Patent No. 6,547,829	Issued: Apr. 15, 2003
-	Huang et al.	U.S. Patent No. 6,895,551	Issued: May 17, 2005
-	Knauft et al.	U.S. Patent No. 6,981,217	Issued: Dec. 27, 2005

- Collerg, et al., "*A Taxonomy of Obfuscating Transformation*," Department of Computer Science University of Auckland, Technical Report #148, New Zealand, XP-002140038, July 1997.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached at (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MN

William L. Bashore

WILLIAM BASHORE
PRIMARY EXAMINER

3/5/2006